

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

CONMED CORPORATION,

Plaintiff,

v.

Civil Action No. 6:13-cv-1226
(GTS/TWD)

IOAN COSMESCU AND I.C. MEDICAL, INC.,

Defendants.

**JOINT CLAIM CONSTRUCTION STATEMENT
PURSUANT TO LOCAL PATENT RULE 4.4**

Pursuant to the U.S. District Court for the Northern District of New York's Local Rule of Procedure for Patent Cases 4.4 and the Court's Uniform Pretrial Scheduling Order (Docket No. 60), Plaintiff Conmed Corporation ("Conmed") and Defendants Cosmescu and I.C. Medical, Inc. ("Defendants") hereby submit the following Joint Claim Construction Statement:

I. Local Patent Rule 4.4(a)(1) – The construction of those terms on which the parties agree.

Following is a chart of the claim terms on which the parties are in agreement as to the construction:

A. U.S. Patent No. 7,935,109

Claim Term	Agreed construction
"a main body having a first end and a second end in continuous communication with one another"	An uninterrupted passageway between the first and second ends of the main body whereby smoke can be evacuated through the main body

B. U.S. Patent No. 8,414,576

Claim Term	Agreed construction
“at least one of an outer body of an ESU pencil and an exhaust port of an integrated smoke evacuation system”	The fixed member is attached to either the outer body of an ESU pencil or the exhaust port of the ESU pencil through which smoke is evacuated
“exhaust port”	The end of an ESU pencil through which smoke may be evacuated
“ at least a portion of an electrical cord for providing power to said ESU pencil or said ESU pencil with an integrated smoke evacuation system is contained within the fixed member and the rotating member”	A portion of the electrical cord that provides power to the ESU pencil is inside the fixed and rotating members

II. Local Patent Rule 4.4(a)(3) – Each party's proposed construction of each disputed term, together with an identification of all references from the intrinsic evidence that support that construction, and an identification of any extrinsic evidence known to the party upon which it intends to rely either to support its proposed construction or to oppose any other party's proposed construction, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of all witnesses including experts.

Following is a chart comparing the parties’ proposed construction of each disputed claim term of each patent at issue along with the evidence to be relied on for each parties’ proposed construction:

A. U.S. Patent No. 7,935,109**1. “multifunctional telescopic electrosurgery pencil”**

Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“an electrosurgery pencil having an electrode that can be extended or retracted and used for both monopolar and bipolar applications”	“an electrosurgery pencil capable of performing more than one electrosurgery function and having a telescopic body”
Plaintiff’s Evidence	Defendants’ Evidence
Abstract; Col. 1, lines 20-51; Col. 1, lines 35-58; Col. 2, lines 23-46; Col. 2, lines 55-59; Col. 2, lines 60-65;	Figures 3 and 4; Col. 2 lns. 50-53; Col. 3. lns. 9-21; Col. 5 lns. 21-24; Col. 6 lns. 19-21, lns. 41-46; Col.7 lns. 37-43;

Col. 2, line 66 – col. 3, line 3; Col. 3, lines 15-21; Col. 3, lines 31-35; Col. 5, lines 58-64; Col. 6, lines 41-46; Col. 8, lines 19-21; Col. 11, lines 13-17; Fig. 1a and 1b, Figs. 2a through 2f, Figs 3a through 3c	Col. 8 lns. 22-31, lns. 40-43, ln.56-Col. 9 ln. 59
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2. “a moveable telescopic body”

Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“a portion of the electrosurgical pencil that can extend or retract from another portion of the pencil to lengthen or shorten the electrode”	“a hollow tubular body that can be extended from and retracted substantially into the main body of the electrosurgery pencil and through which smoke can be evacuated”
Plaintiff’s Evidence	Defendants’ Evidence
Col. 7, lines 52-63; Col. 8, lines 17-21; Figs. 3b and 3c	Figures 3a-3d, telescopic body 44 and 98; Col. 7 lns. 25-30, lns. 53-55; Col. 8 lns. 56-59

3. “contained within at least a portion of the movable telescopic body such that it is capable of being in electrical contact with the energy source”

Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“carried within the extending or retracting portion of the pencil in a manner that maintains electrical contact with the energy source during the extending or retracting”	“the electrode is mounted such that it is inside a portion of the telescopic body and is connected to the energy source that powers the electrosurgery pencil”
Plaintiff’s Evidence	Defendants’ Evidence
Abstract; Col. 1, lines 35-38; Col. 2, lines 60-65; Col. 2, line 6 – col. 3, line 3; Col. 3, lines 31-35; Col. 7, lines 64-67; Col. 8 lines 17-21; Fig. 3c.	Figures 3a-3c, electrode 48, telescopic body 44, conductors 76,78, contacts 80, 82; Col. 7 lns. 23-35, lns. 55-61, lns. 64-67; Col. 8 lns. 17-18, lns.40-55

B. U.S. Patent No. 8,414,576

1. “a first end of a fixed member”

Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“one end of a member separate from	“the end of the fixed member that is

the pencil that is fixed relative to the pencil”	located further than the second end of the fixed member from the exhaust port of the ESU pencil
Plaintiff’s Evidence	Defendants’ Evidence
Title; Abstract; Col. 1, lines 14-22; Col. 2, lines 13-16; Col. 3, lines 45-48; Col. 3, lines 54-57; Col. 4, lines 38-45; Col. 4, line 64 – col. 5, line 10; Figs. 1, 2, 5, 6, 7, and 8.	Figures 1-8, numbers 14, 54; Col. 3 lns. 44-48; Col. 4 lns. 38-45; Application Serial No. 11/164,712 filed Dec. 5, 2005: Figures 1, 4A-4C; paragraphs 21, 24-25

III. Local Patent Rule 4.4(a)(3) – A prioritization of the disputed terms, based upon their significance to the resolution of the case and the court’s construction of those terms and whether they will be case or claim dispositive or substantially conducive to promoting settlement, together with a statement of the significance of each term to the claims and defenses in the case.

With respect to the first patent, all three claim limitations may be dispositive of the issue of infringement. The parties agree that the second and third disputed claim terms are of a higher priority based on their greater significance to the resolution of the case and that their resolution will be either case dispositive or more conducive to promoting settlement. With respect to the second patent, the sole disputed claim element may be dispositive of the issue of infringement and thus will be conducive to promoting settlement.

IV. Local Patent Rule 4.4(a)(4) – The anticipated length of time necessary for the Claim Construction Hearing; and

The parties estimate that 3 to 4 hours should be sufficient for the Claim Construction Hearing.

V. Local Patent Rule 4.4(a)(5) – Whether any party proposes to call any live witnesses to testify at the Claim Construction Hearing, the identity of each such witness and for each witness, a summary of his or her testimony including, for any expert, each opinion to be offered related to claim construction.

Neither Plaintiff nor Defendants intend to call any live witnesses.

FOR PLAINTIFF:

Dated: August 18, 2015

Respectfully submitted,

s/David L. Nocilly

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Dated: August 18, 2015

s/Albert L. Underhill

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